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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,104	11/04/2003	Gregory B. Altshuler	105090-0129	6794
21125	7590	03/26/2009	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604				JOHNSON III, HENRY M
ART UNIT		PAPER NUMBER		
3769				
			NOTIFICATION DATE	DELIVERY MODE
			03/26/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/702,104	ALTSHULER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	HENRY M. JOHNSON III	3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 March 2009.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 74-122 is/are pending in the application.  
 4a) Of the above claim(s) 88,89,91,93 and 95-122 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 74-87,90,92 and 94 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 07 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>030409</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

***Election/Restrictions***

Newly submitted claims 88, 89, 91, 93 and 95-122 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: an election of species was made based on figure 2 and claims 1, 2, 4-9, 11-14, 16, 17, 19-23 and 55 were examined, thus establishing the limitations for the application. While the new claims are supported by the original disclosure, they are not supported by the originally elected claims because they cite limitations in alternative species and a distinct invention (method claims).

Since applicant has received multiple actions on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 88, 89, 91, 93 and 95-122 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

Applicant's arguments filed February 26, 2009 with respect to claims have been considered but are not persuasive. The argument is based on a subjective determination as to whether a structure is shaped to apply a compressive force. This is interpreted by the examiner as a capability of the structure based on the intended use. The protuberances of Mink are clearly capable of providing such force and in doing so would render the light emitted to be below a skin surface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 74-76, 79-80, 83, 84, 87 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent G 91 02 407.2 to Mink. Mink discloses a hairbrush (applicator) for delivery of optical radiation via light guides, each guide having a laser diode (semiconductor) as its source (Fig. 1, # 20). The multiple diodes are interpreted as an array. A cooling radiator (Fig. 2, # 24) acts as a heat sink for the radiation sources. The light conductors are interpreted as protuberances or bristles of a brush and are capable of providing a compressive force during use. A handle is disclosed (Fig. 1, # 2) clearly indicating the device may be handheld. The examiner considers the activation of the sources as inherent with the intended use of the device and therefore continuous or pulsed radiation is inherent. It is noted for the record that no power source or control means is cited.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

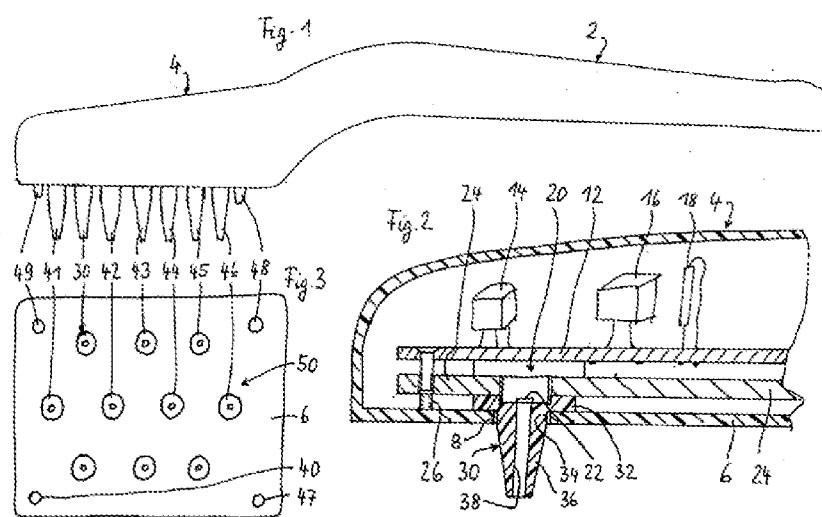
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 77 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent G 91 02 407.2 to Mink as applied to claim 74 above, and further in view of U.S. Patent 5,300,097 to Lerner et al. Mink is discussed above, but does not teach a specific intensity. Lerner et al. disclose a handheld tissue radiation unit and teach the radiation provided may be from 1-10 mW/cm<sup>2</sup> or from 30-1000 mw/cm<sup>2</sup> (Col. 2, lines 47-49). It would have been obvious to one skilled in the art to use the intensities as taught by Lerner et al. in the invention of Mink as the selection of the treatment intensities is based on the intended treatment and a skilled artisan would select the power as appropriate.

Claims 81, 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over



German Patent G 91 02 407.2 to Mink. Mink teaches multiple laser diodes and multiple LEDs. Both are well known in the art to be available in a wide range of wavelengths and intensities. It would have been obvious to one skilled in the art to

select one or more wavelengths and/or intensities as appropriate for the desired treatment and the device of Mink is clearly capable of operating with multiple combinations of light sources.

Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent G 91 02 407.2 to Mink as applied to claim 74 above and further in view of U.S. Patent 5,445,608

to Chen et al. Mink is discussed above, but does not teach application of an agent to the treatment area. Chen et al. teach a device that provides for the delivery of an agent to the treatment site concurrent with radiation (Fig. 16A). It would have been obvious to one skilled in the art to use the agent delivery as taught by Chen in the invention of Mink as the use of agents, such as a photosensitizer, is well known to a skilled artisan as would be the various methodologies for delivery of a photosensitizer; i.e. systemic, direct, etc.

Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent G 91 02 407.2 to Mink as applied to claim 74 above and further in view of U.S. Patent 6,129,723 to Anderson et al. Mink is discussed above, but does not teach limiting radiation using total internal reflection and contact with skin. Anderson et al. teach a method of restricting the radiation emitted to a target surface by use of total internal reflection wherein the angles where the radiation encounters different indexes of refraction allow or do not allow the radiation to pass. Such an interface is disclosed as where a lightguide contacts tissue and allows light passage and one where an air interface does not (Col. 7, lines 60-67). It would have been obvious to one skilled in the art to use the radiation inhibitor as taught by Anderson et al. in the device of Mink as any device with laser radiation has inherent safety issue with stray radiation that can be harmful to the human eye and a skilled artisan would take every effort to minimize the potential stray radiation.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to HENRY M. JOHNSON III at telephone number (571)272-4768.

/Henry M. Johnson, III/  
Supervisory Patent Examiner, Art Unit  
3769

3/21/2009